

Appln. No. 10/643,504
Amendment dated October 19, 2005
Reply to Office Action of May 19, 2005

REMARKS

Introduction

Claims 1-31 were pending in the present application. Independent claims 1, 5 and 31 and dependent claims 2-4 and 6-23 stand rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the written description requirement. Claims 1-31 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending U.S. Patent Application No. 10/638,921, which is under examination and has not yet been allowed. Claims 1-4 and 31 stand rejected under 35 U.S.C § 103(a) as being unpatentable over a hypothetical combination of U.S. Patent No. 6,424,845 to Emmoft, and U.S. Patent No. 6,695,215 to Robertson. Claims 5, 6, 9-20, 23 and 31 stand rejected under 35 U.S.C § 103(a) as being unpatentable over the hypothetical combination of Emmoft, Robertson and U.S. Patent No. 6,315,207 to Eisele. Claims 7, 8, and 21 stand rejected under 35 U.S.C § 103(a) as being unpatentable over the hypothetical combination of Emmoft, Robertson, Eisele, and U.S. Patent No. 6,125,192 to Bjorn et al. Claims 24-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the hypothetical combination of Emmoft and U.S. Patent No. 4,636,622 to Clark. In the present Amendment, claims 1, 5, 24 and 31 have been amended. The specification has also been amended. Accordingly, claims 1-31 are pending in the application. Claims 1, 5, 24, and 31 are independent.

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Rejection Under 35 U.S.C § 112, First Paragraph

Independent claims 1, 5 and 31 and dependent claims 2-4 and 6-23 stand rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner contends that the text of the specification does not contain the language "the receptacle including a cut away section for viewing substantially all of a side of the ID card."

By the present amendment, the specification has been amended to describe the the receptacle having a cut away section for viewing substantially all of a side of the ID card. Support for this language can be found in the specification as filed at, for example, FIG. 12. As described in the Specification of the present application, the cut away of the present application:

permits unobstructed viewing of names, numbers, symbols, and/or photographs printed on the intelligent ID card. [FIG. 12] shows an exemplary embodiment of an intelligent ID card holder...[t]he card is supported in the holder by rails 1205. The viewing area of the card can be left open, or can be covered by a transparent material such as a clear plastic window.

Present Application, as published, at paragraph [0049], and FIG. 12. As can be seen in FIG. 12 of the present application, as filed, substantially all of a side of an ID card can be viewed by way of an embodiment of the claimed ID card holder.

Accordingly, Applicant submits that the rejections under 35 U.S.C § 112, first paragraph, have been overcome, and Applicant respectfully requests that the rejections to independent claims 1, 5 and 31 and dependent claims 2-4 and 6-23 under 35 U.S.C § 112, first paragraph, be withdrawn.

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Non-Statutory Double Patenting Rejections

Claims 1-30 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending U.S. Patent Application No. 10/638,921, which is under examination and has not yet been allowed.

Applicant acknowledges the provisional non-statutory double patenting rejections set forth in the Office Action. By this Amendment, Applicant addresses the other rejections set forth in the Office Action. Applicant respectfully submits that, due to the provisional nature of the non-statutory double patenting rejections, the provisional non-statutory double patenting rejections will be addressed at a later date, as necessary.

Rejections Under 35 U.S.C § 103(a)

Claims 1-4 and 31 stand rejected under 35 U.S.C § 103(a) as being unpatentable over a hypothetical combination of U.S. Patent No. 6,424,845 to Emmoft, and U.S. Patent No. 6,695,215 to Robertson.

Applicant respectfully submits that the proposed hypothetical Emmoft-Robertson combination does not describe all of the features claimed by amended claim 1 of the present application. For example, amended claim 1, which is directed to an intelligent ID card holder for an intelligent ID card, recites, *inter alia*, a receptacle including two major surfaces with an opening formed between the two surfaces to accept the intelligent ID card into the receptacle, wherein one of the surfaces has a cutaway section for viewing substantially all of a side of the ID card, the receptacle also including first and second rails for supporting the intelligent ID card.

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Emmofit is directed to a portable communication device that can receive one or more smart cards. Emmofit describes the communication device having two receiving slots for receiving two separate smart cards. Via a wireless electronic transaction, funds can be transferred from a bank, to the portable communication device, and then to a designated one of the smart cards. Emmofit describes that smart cards could be used for performing financial transactions such as purchasing goods in a store. Emmofit also describes that the portable communication device can include a fingerprint sensor, which could be used to authenticate the user of the smart cards by comparing fingerprint data with data stored at the communication device. If the user is authorized, communications with a remote location can take place. The device described by Emmofit includes entry slots 22 for receiving t-shaped smart cards 23. See Emmofit at col. 2, lns. 32-35 and FIG. 1.

Thus, Emmofit does not describe, for example, a receptacle including first and second rails for supporting an intelligent ID card. Instead, Emmofit describes entry slots 22 for receiving t-shaped smart cards 23. Robertson does not cure this deficiency.

Robertson describes a card reader device 200 having a slot 202 wherein a card 100 can be inserted, and viewed through window 244. See Robertson at col. 4, lns. 28-46 and FIGs. 1A, 2A and 2B. Because of the orientation of the card with in the Robertson design, Robertson does not make use of, describe, nor suggest rails for supporting the card.

As described in the Specification of the present application, the particular combination and orientation of a cut away section and rails in the claimed design of the present application:

permits unobstructed viewing of names, numbers, symbols, and/or photographs printed on the intelligent ID card. [FIG. 12] shows an

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exemplary embodiment of an intelligent ID card holder...[t]he card is supported in the holder by rails 1205. The viewing area of the card can be left open, or can be covered by a transparent material such as a clear plastic window.

Present Application, as published, at paragraph [0049], and FIG. 12. As can be seen in FIG. 12 of the present application, as filed, the rails serve to position and support the card such that substantially all of a side of an ID card can be viewed by way of an embodiment of the claimed ID card holder.

Accordingly, Applicant submits that claim 1, as amended, of the present application is patentable over the hypothetical combination of Emmoft and Robertson, and withdrawal of the rejection to that claim under 35 U.S.C § 103(a) is respectfully requested.

Dependent claims 2-4, each depend from claim 1. Accordingly, Applicant submits that claims 2-4 of the present application are each patentable over the hypothetical combination of Emmoft and Robertson, at least for the reasons stated above with respect to the rejection to claim 1, and withdrawal of the rejections to claims 2-4 under 35 U.S.C. § 103(a) is respectfully requested.

Independent claim 31 has been amended to recite features similar to those discussed above with respect to claim 1. For example, claim 31 recites an authentication system using an intelligent ID card holder coupled to a computer network to compare sensed user features to stored features on a network comprising, *inter alia*, a receptacle for receiving the intelligent ID card, the receptacle electrically communicating with the intelligent ID card by contacts or RF antenna, the receptacle including a cut away section for viewing substantially all of a side of the ID card, the receptacle also including first and second rails for supporting the intelligent ID card.

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Accordingly, Applicant submits that independent claim 31 of the present application is patentable over the hypothetical combination of Emmoft and Robertson, at least for the reasons stated above with respect to the rejection to claim 1, and withdrawal of the rejection to claim 31 under 35 U.S.C. § 103(a) is respectfully requested.

Claims 5, 6, 9-20, 23 and 31 stand rejected under 35 U.S.C § 103(a) as being unpatentable over the hypothetical combination of Emmoft, Robertson and U.S. Patent No. 6,315,207 to Eisele.

Independent claim 5 has been amended to recite features similar to those discussed above with respect to claims 1 and 31. For example, amended claim 5 recites, *inter alia*, an intelligent ID card holder to authenticate a user comprising a receptacle including two major surfaces with an opening formed between the two surfaces to accept the intelligent ID card into the receptacle, wherein one of the surfaces has a cutaway section for viewing substantially all of a side of the ID card, the receptacle also including first and second rails for supporting the intelligent ID card.

Thus, for reasons described above with respect to the rejections to claims 1 and 31, Applicant submits that neither Emmoft nor Robertson describe or suggest all of the features recited by amended claim 5 of the present application.

Eisele does not cure these deficiencies. Eisele describes a smart diskette adapter for receiving a smart diskette. In turn, Eisele further describes a smart diskette capable of receiving a smart card. Eisele describes that the smart diskette adapter could be used to store information, such as a spread sheet, perpetual calendar, or a telephone directory on a smart card. As described by Eisele, the stored data could be communicated to a personal computer. Eisele

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also describes the smart diskette having a cut-out 704 for facilitating grasping the card. See Eisele at FIG. 7a, and col. 10, lns. 61-62. Due to the design and configuration of the apparatus of Eisele, Eisele does not describe the claimed features of a receptacle including two major surfaces with an opening formed between the two surfaces to accept the intelligent ID card into the receptacle, wherein one of the surfaces has a cutaway section for viewing substantially all of a side of the ID card, the receptacle also including first and second rails for supporting the intelligent ID card.

Accordingly, Applicant submits that independent amended claim 5 of the present application is patentable over the hypothetical combination of Emmoft, Robertson and Eisele, and withdrawal of the rejection to that claim under 35 U.S.C. § 103(a) is respectfully requested.

Dependent claims 6, 9-20 and 23, each ultimately depend from claim 5. Accordingly, Applicant submits that claims 6, 9-20 and 23 of the present application are each patentable over the hypothetical combination of Emmoft, Robertson and Eisele, at least for the reasons stated above with respect to the rejection to claim 5, and withdrawal of the rejections to claims 6, 9-20 and 23 under 35 U.S.C. § 103(a) is respectfully requested.

As stated above, amended independent claim 31 has been amended to recite features similar to those discussed above with respect to claims 1 and 5. For example, as described above, claim 31 recites an authentication system using an intelligent ID card holder coupled to a computer network to compare sensed user features to stored features on a network comprising, *inter alia*, a receptacle for receiving the intelligent ID card, the receptacle electrically communicating with the intelligent ID card by contacts or RF antenna, the receptacle

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including a cut away section for viewing substantially all of a side of the ID card, the receptacle also including first and second rails for supporting the intelligent ID card.

Thus, for reasons described above with respect to the rejection to claim 5, Applicant submits that neither Emmoft, Robertson, nor Eisele describe or suggest all of the features recited by amended claim 31 of the present application. Accordingly, Applicant submits that independent amended claim 31 of the present application is patentable over the hypothetical combination of Emmoft, Robertson and Eisele, and withdrawal of the rejection to that claim under 35 U.S.C. § 103(a) is respectfully requested.

Claims 7, 8, and 21 stand rejected under 35 U.S.C § 103(a) as being unpatentable over the hypothetical combination of Emmoft, Robertson, Eisele, and U.S. Patent No. 6,125,192 to Bjorn et al.

Dependent claims 7, 8, and 21, each ultimately depend from claim 5. Accordingly, Applicant submits that claims 7, 8, and 21 of the present application are each patentable over the hypothetical combination of Emmoft, Robertson and Eisele, at least for the reasons stated above with respect to the rejection to claim 5.

Bjorn does not cure these deficiencies. Bjorn describes a fingerprint recognition system including a fingerprint sensing device that can be coupled to a computer system and used to authenticate users of the system. Bjorn describes a system wherein the effects of smudges on a fingerprint plate can be minimized via certain digital image processing techniques. Thus, Bjorn does not describe or provide motivation for the claimed ID card holder.

Specifically, Bjorn does not describe a card or card holder, nor any an intelligent ID card holder to authenticate a user comprising a receptacle including two major surfaces with

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an opening formed between the two surfaces to accept the intelligent ID card into the receptacle, wherein one of the surfaces has a cutaway section for viewing substantially all of a side of the ID card, the receptacle also including first and second rails for supporting the intelligent ID card.

Accordingly, Applicant submits that claims 7, 8, and 21 of the present application are patentable over the hypothetical Emmoft-Robertson-Eisele-Bjorn combination, at least for the reasons stated above with respect to the rejection to claim 5, and withdrawal of the rejection to those claims under 35 U.S.C. § 103(a) is respectfully requested.

Claims 24-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the hypothetical combination of Emmoft and U.S. Patent No. 4,636,622 to Clark.

Claim 24, as amended, of the present application, is directed to a method of using an intelligent ID card holder to authenticate a user of an intelligent ID card. The claim recites inserting an intelligent ID card into the ID card holder, sensing a feature of the user at the ID card holder, storing information related to the feature at the ID card holder, retrieving a stored image of the user's feature from a remote computer located remote to the ID card holder, comparing, at the ID card holder, the sensed feature to a stored image of the user's feature, authenticating the user, and acting on the authentication.

Applicant respectfully submits that Emmoft does not describe all of the features claimed by amended claim of the present application. For example, claim 24 recites sensing a feature of the user at the ID card holder, storing information related to the feature at the ID card holder, retrieving a stored image of the user's feature from a remote computer located remote to the ID card holder, comparing, at the ID card holder, the sensed feature to a stored image of the user's feature, authenticating the user, and acting on the authentication.

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In stark contrast, Emmoft only describes an authorized image being stored on the transaction processor (communication device). See Emmoft at col. 2, lns. 61-67. Emmoft does not describe an image or feature being retrieved from a remote computer, and comparing the sensed feature at the card holder. Accordingly, Applicant submits that claim 24, as amended, of the present application is patentable over Emmoft.

Clark does cure this deficiency. Clark describes a system whereby a standard credit card swiping device includes a fingerprint reader. After a fingerprint is read at the device, a fingerprint image is transmitted to a remote central station for comparison with a remotely stored image. See Clark at FIG. 1 and col. 2, lns. 32-47. Clark does not describe sensing a feature of the user at an ID card holder, storing information related to the feature at the ID card holder, retrieving a stored image of the user's feature from a remote computer located remote to the ID card holder, comparing, at the ID card holder, the sensed feature to a stored image of the user's feature, authenticating the user, and acting on the authentication.

Accordingly, Applicant submits that amended claim 24 of the present application is patentable over the hypothetical Emmoft-Clark combination, and withdrawal of the rejection to that claim under 35 U.S.C § 103(a) is respectfully requested.

Claims 25-30 depend from claim 24. Accordingly, Applicant submits that claims 25-30 of the present application are patentable over the hypothetical Emmoft-Clark combination, at least for the reasons stated above with respect to the rejection of claim 24, and withdrawal of the rejections to those claims under 35 U.S.C § 103(a) is respectfully requested.

Moreover, Applicant submits that the proposed Emmoft-Clark combination is improper because the Examiner has not set forth any motivation to combine the references.

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Clark describes a standard credit card reader system, which works under a system very different from that of a smart card system, wherein memory and processing are provided at the card level. Accordingly, Applicant submits that neither Emmoft nor Clark provide motivation to combine the references.

Accordingly, for this additional reason, Applicant submits that claims 24-30 of the present application are patentable over the hypothetical Emmoft-Clark combination, and withdrawal of the rejections to those claims under 35 U.S.C § 103(a) is respectfully requested.

Applicant respectfully submits that none of the cited references, either taken alone, or in any proposed hypothetical combination, teach, suggest, or provide motivation for any of the claimed inventions in the present application.

In view of the above remarks, an early allowance of the present application is respectfully requested.

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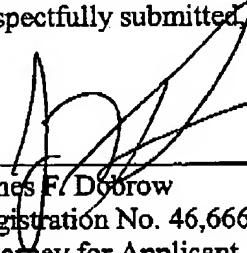
CONCLUSION

The Commissioner is authorized to charge any underpayment of fees to Deposit
Account No. 501358.

Applicant's undersigned attorney may be reached by telephone at (973) 597-2500.

All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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